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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,628	03/23/2001	Frank Venegas JR.	IDS-11605/14	4648

7590

12/04/2002

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EXAMINER

MACARTHUR, VICTOR L

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/815,628

Applicant(s)

VENEGAS, FRANK

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-8, 15-21 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 4, 16 and 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8, 15, 17 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Election/Restriction***

Claims 4, 16, and 18-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

#### ***Claim Rejections - 35 USC § 103***

Claims 5, 6, 8, 15, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5396739 to Venegas in view of USPN 4053140 to Clemens.

Regarding claim 17, Venegas (USPN 5396739) discloses (figs.1-3) a handrail assembly with an infill panel, comprising: a pair of spaced apart vertical posts (18) each having a lower end and an upper end, the lower ends being configured to engage a support surface (48), each of the posts having a height and an outside diameter; replaceable polymerized sheathing (14) surrounding each of the posts, the sheathing having an inner diameter equal to or greater than the outside diameter of the posts, the sheathing extending substantially the entire height of the posts; an upper rail (24) extending between the upper ends of the vertical posts and engaged to the upper ends of the vertical posts, the upper rail having a length and an outside diameter; a lower rail (28) extending between the vertical posts and positioned below the upper rail, the lower rail engaged to the vertical posts and having a length and an outside diameter; replaceable

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polymerized sheathing (14) surrounding each of the rails, the sheathing having an inner diameter equal to or greater than the outside diameter of the rails, the sheathing extending substantially the entire length of the rails; the vertical posts and the rails together defining a perimeter frame having a framed area defined therein, the framed area having a top edge defined by the upper rail, a lower edge defined by the lower rail, and sides defined by the vertical posts; and an infill panel (40) supported in the framed area. Venegas does not disclose that the rails are releasably engaged to the posts. Clemens teaches slip-on structural fittings (18h) interconnecting rails (20) with posts (44), which facilitate connection of members to be readily modified to any shape or configuration at the location of the structure with hand tools (col.1, ll25-55). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made modify the rails, posts and sheathing of Venegas (USPN 5396739) to be releasably engaged by slip-on structural fittings, as taught by Clemens, for the purpose of facilitating connection of members to any shape or configuration.

As to claim 5, Venegas (USPN 5396739) as modified by Clemens discloses the handrail assembly as defined in claim 17, wherein the infill panel has an area, which substantially consumes the framed area; the panel being mounted in the framed area.

As to claim 6, Venegas (USPN 5396739) as modified by Clemens discloses the handrail assembly as defined in claim 5, further comprising one or more sections of U-channel (32) affixed to each of the vertical posts and the rails for mounting the infill panel.

As to claim 8, Venegas (USPN 5396739) as modified by Clemens discloses the handrail assembly as defined in claim 5, wherein the infill panel is a solid panel.

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As to claim 15, as noted in the 103 rejection of claim 17, above, Venegas as modified by Clemens discloses all the limitations of claim 15, present in claim 17. Furthermore, while Clemens does not explicitly disclose that the inside diameter of the slip-on structural fittings is larger than the sheathing of Venegas, the combination of Clemens and Venegas necessarily requires such an inner diameter in order to maintain the Slip-on feature of Clemens and maintain the surface contact between the sheathing and rail members as disclosed by Venegas.

As to claim 25, Venegas (USPN 5396739) as modified by Clemens discloses the handrail assembly as defined in claim 17, wherein each of the horizontal rails and the vertical posts comprise substantially straight members and the polymerized sheathing is substantially straight.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5396739 to Venegas in view of USPN 4053140 to Clemens as applied to claim 5 above, and further in view of USPN 5186438 to Cross.

Venegas (USPN 5396739) as modified by Clemens discloses the handrail assembly as defined in claim 5. Venegas does not disclose that the infill panel is a mesh screen. Cross teaches (col.3, ll.60-65) mesh panels that can withstand repeated strikes. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the hand rail assembly of Venegas to incorporate a mesh panel, for the purpose of better allowing the fence to withstand repeated strikes.

***Response to Arguments***

Applicant's arguments filed on 11/06/02 with regard to the claim rejections have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to combine Venegas and Clemens comes from Clemens (col1, ll.25-55), which states fittings allow for unit modification to any shape or configuration.

In response to applicant's argument that "the infill panel cannot be easily added to Clemens, and the Clemens' fittings cannot be applied to Venegas", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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In response to applicant's argument citing *In Re Dembiczak*, the examiner notes that the final ruling in the case states that there is no evidence in the record of a suggestion, teaching, or motivation to combine the prior art references. However, this does not apply to the instant application since in this case, motivation to combine Venegas and Clemens comes from Clemens (coll, ll.25-55), which teaches that fittings allow for unit modification to any shape or configuration. Therefore, one would be motivated to combine the Clemens fittings with the Venegas hand rail assembly in order to allow for the hand rail assembly to be modifiable to any shape or configuration.

In response to applicant's argument that the sheathing of Venegas is not replaceable, the examiner notes that figure 3 of Venegas shows that the sheathing (14) is in fact removable and replaceable.

### ***Conclusion***

This application contains claims 4 and 18-21 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (703) 305-5701. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*VLM*

VLM  
December 2, 2002

*Lynne H. Browne*

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